

REMARKS

Claims 1-20 are now pending in this application.

The Examiner maintains the prior art rejections set forth in the previous office action:

- claims 15, 16, 18 and 20 under 35 U.S.C. 102(e) as being anticipated by Back et al. (Back);
- claims 1-4, 6-12 and 14 under 35 U.S.C. 103(a) as being unpatentable over Back in view of Jain et al. (Jain);
- claims 5 and 13 under 35 U.S.C. 103(a) as being unpatentable over Back and Jain in view of Kotzin et al. (Kotzin); and
- claims 17 and 19 under 35 U.S.C. 103(a) as being unpatentable over Back in view of Kotzin.

Applicant amends independent claims 15 and 18 in order to more clearly recite the features set forth in the original claims, and amends the dependent claim 16 to ensure consistency with its base claim 15. Applicant respectfully traverses the prior art rejections as follows.

As explained in detail in Applicant's Response filed July 7, 2006, Back (the Examiner's primary reference) does not disclose, teach, or suggest the unique combinations of features or method steps as recited in Applicant's respective independent claims 1, 8, 15 and 18. In particular, Applicant's independent claim 8 provides a system for handing over a terminal from a first base station to a second base station, the system comprising a unique combination of features, including, *inter alia*, providing a roaming gateway and using an inter-system paging procedure without having to establish other systems separately (*see* Applicant's claim 8). On the other hand, Applicant's independent claim 1 provides a method for handing over a terminal from a first base station to a second base station, the method comprising a unique combination of method steps, including, *inter alia*, performing notification via a roaming gateway and inter-system paging without having to establish other systems separately (*see* Applicant's claim 1). Independent claims 15 and 18 provide methods, for handing over a terminal from a first base station to a second base station, each method comprising a unique combination of method steps,

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including, *inter alia*, performing of an initialization operation by a terminal for communication with a second base station in a second communication mode (*see* Applicant's claims 15 and 18).

In reply to the arguments presented in Applicant's Response filed July 7, 2006 (which arguments are hereby incorporated by reference in this Amendment), the Examiner alleges that the feature of (1) the initialization operation being performed between the user equipment (UE) and a second base station, and (2) the UE notifying the source base station controller (BSC) regarding terminal readiness, are not recited in the rejected claims. The Examiner's latest comments on the applicability of Jain and Back references are essentially identical to those set forth in the first Office Action mailed February 8, 2006. (*See* final Office Action, paragraph 3).

After careful consideration of the Examiner's reply, Applicant respectfully submits that the above-referenced feature (1) is explicitly recited in the independent claims which include the recitation of "performing of an initialization operation by said terminal for communication with said second base station in said second communication mode" (claim 15 and 18). On the other hand, claims 1 and 8, recite that "said terminal performs an initialization operation based on said second communication mode with said second base station", and include the recitation of "notifying said first mobile switching center by said first base station controller that said terminal has completed said second communication mode-based initialization operation with said second base station" that explicitly means notification that the terminal is ready to perform handover with a second base station.

Accordingly, Applicant's independent claims 15 and 18, as well as the dependent claims 16 and 20 (which incorporate all the novel and unobvious features of their respective base claims 15 and 18), are not anticipated by (i.e., are not readable on) Back at least for the reasons set forth above and in Applicant's Response filed July 7, 2006.

Also, Applicant's independent claims 1 and 8, as well as the dependent claims 4-6 and 12-14, would not have been obvious from any reasonable combination of Back, Jain and Kotzin, at least for the reasons set forth above and in Applicant's Response filed July 7, 2006. Likewise, dependent claims 17 and 19, which incorporate all the novel and unobvious features of their respective base claims 15 and 18, would not have been obvious from any reasonable

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combination of Back and Kotzin at least for the reasons set forth above with regard to claims 15 and 18.

In view of the above, reconsideration and allowance of this application with claim 1-20 are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 18-2220. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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